

ELECTRODE FORMING METHOD

Examiner: Z. Best S.N. 10/525,202 Art Unit: 1795

Election/Restrictions

1. Applicant's election of Claims 8-12 in the reply filed on February 16, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-7 are withdrawn. Claims 8-12 are currently pending examination.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "[t]he laminate". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oguro et al. (EP 0943402 A2) in view of Kaneto et al. (US 5,556,700 A).

Regarding Claims 8-10, Oguro et al. teach a laminate (1) comprising a solid electrolyte layer (2) and an electrode layer (3), which is used as an electrochemical actuator (abstract), wherein the thickness of the actuator elements affects the deformation properties of the actuator (par. 89). However, Oguro et al. do not specifically teach the laminate is as thick as 1 cm.

Kaneto et al. teach that polymer actuators can be constructed in various dimensions depending on its desired end use, which may be as thick as 1 cm (col. 5, line 64 – col. 6, line 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to adjust the thickness of the actuator element of Oguro et al. because Kaneto et al. teach polymeric actuators can be constructed in various dimensions depending on its desired end use, which may be as thick as 1 cm and simple substitution of

one known element for another to obtain predictable results is obvious. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007). Additionally, changes in size and shape are obvious. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984).

Regarding Claims 11-12, Oguro et al. and Kaneto et al. teach the laminate (actuator element) as recited above. It is the position of the Examiner that the intended use as claimed in Claims 11-12 does not add structure to the claim. Intended use of a known product does not give it patentable weight in the product claim. See MPEP 2106(C).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary Best whose telephone number is (571) 270-3963. The examiner can normally be reached on Monday to Thursday, 7:30 - 5:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on (571) 272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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